

REMARKS

Claims 1-7 and 9-30 are pending. By this amendment, claim 11 is amended.

Reconsideration in view of the above amendments and the following remarks is respectfully requested.

At the outset, Applicant respectfully submits that the finality of the Office Action has been made prematurely. In particular, in the November 28, 2005 Office Action, it was indicated that claims 7 and 8 were objected to but would be allowable if placed into independent format. Partly in response to that indication, claim 1 was amended to include the blower and a muffler which were previously recited in claim 7. In the present final Office Action, claim 7 is rejected based on U.S. Patent No. 5,272,285 to Miller despite the fact that the combination of claims 1 and 7 remains substantially unchanged. Moreover, despite the amendment of claim 1 in the February 27, 2006 Amendment to include additional features while removing none, dependent claim 7 is now rejected based on the same reference that was of record and applied in the previous Office Action. As the current rejection is a Final Rejection, Applicant has not had a fair chance or opportunity to consider the new rejection of claim 7, which was not based on Applicant's amendment or argument, but rather, based on the Examiner's new interpretation and/or reevaluation of that reference.

In addition, the current Office Action does not address new claims 27-30, although they are included within the general rejection of several of the claims under 35 U.S.C. §102(b) over Miller. For example, Miller clearly does not teach or suggest an apparatus for supplying breathable gas which includes a noise suppressing member consisting essentially of a thin flexible enclosure provided to the electric motor. Miller discloses a clam-shell type sound attenuating design and includes an outer layer of a relatively rigid, bendable, resilient material

and an inner layer of flexible sound absorbent material. See column 2, lines 61-64. Miller's background is specifically directed toward overcoming the shortcomings of prior art mufflers which include a highly flexible, laminate blanket-like covers that are not sufficiently rigid to retain a given shape separate and apart from the tool body about which they are to be wrapped. Miller also recognizes that the wrapping of highly flexible sound absorbent covers about machinery is cumbersome and indicates the desirability to have a cover which is sufficiently rigid to retain a desirable form. See column 1, lines 21 through 52 of Miller.

Accordingly, Miller teaches directly against the subject matter of all of the independent claims of this application which set forth a thin flexible enclosure (claims 1, 9 and 18) or a flexible bag-like plastic material enclosure (claim 11), much less a noise suppressing member consisting essentially of a thin flexible enclosure (claim 27). While Miller specifies that the layer 16 is preferably constructed a fiberglass or other flexible and suitably sound absorbent material, that material is then attached to the interior surfaces of the outer layer by means of glue, pressure sensitive adhesive, or the like. Thus, Miller teaches the combination of a rigid outer shell and an inner layer that is essentially affixed to the inner shell, such that the overall design does not constitute a thin flexible enclosure as recited in claims 1, 9, 18 and 27, or a flexible bag-like plastic material enclosure, as recited in claim 11. Miller's clam shell and inner layer certainly cannot qualify as a flexible bag-like plastic material enclosure, as recited in claim 11, given that Miller's main purpose is to provide a cover which is sufficiently rigid to retain a desirable form per column 1, lines 21-52. Moreover, Miller's layer 14 cannot qualify as an enclosure since it is simply a layer that is affixed to the shell.

In addition, claim 1 is directed to an apparatus for supplying breathable gas which includes relatively rigid external housing and a noise producing component including an electric

motor blower and at least a first muffler. In the Office Action (page 3, paragraph 7), it is stated that "...compressors are know (sic) to be run by electricity to power a motor producing air."

However, Miller does not teach or suggest an electric motor blower. While it is possible that the compressor shown in Miller may be powered by electricity, there is no teaching or suggestion that the compressor includes an electric motor blower which is "internal to the housing", as recited in claim 1. In accordance with MPEP 2144.03, part C, the Examiner is requested to identify in Miller where it teaches the use of an electric motor blower, or to identify the "known prior art" identified in paragraph 7 of the Office Action so that the Applicant may assess this undisclosed prior art and determine whether it is in fact combinable with the teachings of Miller.

With respect to method claim 9, Applicant respectfully submits that the first step of "assembling an apparatus for supplying breathable gas" is part of the method which the Examiner must consider but has to date ignored merely because it occurs in the preamble. This is a positively recited method step and must be considered. Miller does not teach or suggest the step of assembling an apparatus for supplying breathable gas, much less the sub-steps recited in the main body claim 9. For example, claim 9 is directed to providing at least one noise producing component in a subassembly, placing the subassembly into an interior of a flexible enclosure through an opening therein, substantially sealing or closing the opening and subsequently, placing the flexible enclosure within the external housing. In Miller, the noise producing component 12 is placed into contact with the inner layer 16 which has previously been adhered to or otherwise affixed to the shelf 14. As such, any "opening" of layer 16 cannot be sealed or closed before placing the flexible enclosure (with the noise producing component) within an external housing. Thus, Miller does not teach or suggest substantially sealing or

closing the opening (with the noise producing component subassembly therein), and subsequently placing the flexible enclosure within an external housing, as recited in claim 9.

With regard to claim 11, Miller does not teach or suggest that the enclosure includes a wiring aperture for passage of one or more wires for transmitting power or control signals to an electric motor and/or other electrical components, the wiring aperture being substantially closed or sealable relative to the exterior of the wire(s). This subject matter is adopted from dependent claim 8, which the Office Action identifies as containing allowable subject matter. While this indication was in conjunction with claim 8, which depends from claim 7, which in turn depends from claim 1, it is believed that the indication of allowable subject matter regarding claim 8 was independent of the subject matter of claim 7 since in fact, claim 7 was rejected based on Miller. If Applicant's understanding is incorrect, the Examiner is invited to contact the undersigned to discuss possible further amendment of claim 11.

In regard to claim 18, Miller does not teach an apparatus for supplying breathable gas which includes a relatively rigid external housing, at least one noise producing component internal to the housing and a thin flexible enclosure provided for said at least one noise producing component, said enclosure being substantially independent of the external housing. Miller teaches that its layer 16 is affixed to or essentially adhered to the substantially rigid shell 14. Thus, the layer 16 is not independent of the housing 14, as recited in claim 18. The Examiner has cited case law (*Nerwin v. Erlichman*) for its alleged holding that "constructing a formerly integral structure in various elements involves only routine skill in the art." This case law is not relevant to the present situation in which claim 18 specifies that the enclosure (or the shape thereof per claim 21) is substantially independent of the external housing.

By necessity, the enclosure and the external housing in Miller must have the same shape in order to accommodate the compressor. Certainly the enclosure and the external housing of Miller do not have a dissimilar shape per claim 22. The independent nature of the enclosure compared to the external housing allows noise suppression of one or more components within a blower housing, while the remaining portions the internal to the housing need not be enclosed. Because the noise making components can vary in number, size and shape, the enclosure (or shape thereof – claim 21) is made independent of the housing (and even dissimilar to the housing – claim 22). Moreover, the layer 16 does not constitute a thin flexible enclosure, as recited in claim 18. Miller's design includes a clam shell configuration in which one half is pivotable relative to the other half. However, the layer in this configuration does not form an enclosure. If anything forms an enclosure, it is the shell 14, which the Examiner has identified as the rigid external housing.

Independent claim 27 has been discussed above. To emphasize, Miller does not teach or suggest a noise suppressing member consisting essentially of a thin flexible enclosure provided to the electric motor. Miller teaches against the use of the flexible prior art muffler coves identified in column 1, lines 21-52, and instead solves the problems with the prior by using a muffling assembly which is sufficiently rigid to retain a desirable form. Thus, Miller does not teach the subject matter of claim 27.

In regard to dependent claim 24, Applicant appreciates that the Office Action, in paragraph 14, acknowledges that Miller fails to teach the claimed subject matter. However, the Examiner then takes the position that it is well known in the art of compressors that the pressure of the air existing the compressor is adjustable including within the claimed range. This rejection is respectfully traversed since Miller does not teach the claimed range. If this rejection

DANTANARAYANA

Appl. No. 09/868,875

January 17, 2007

is maintained in the next Office Action, the Examiner is requested to produce a reference which teaches this subject matter, so that Applicant may consider its teaching, and determine whether it is in fact combinable with Miller. See MPEP 2144.03.

In view of the above amendments and remarks, Applicant respectfully submits that all the claims are patentable and that the entire application is in condition for allowance.

Should the Examiner believe that anything further is desirable to place the application in better condition for allowance, he is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By: _____



Paul T. Bowen
Reg. No. 38,009

PTB:glf
901 North Glebe Road, 11th Floor
Arlington, VA 22203-1808
Telephone: (703) 816-4000
Facsimile: (703) 816-4100